

**REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

Claims 19 - 21, 23 - 34, 29, and 34 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. See Office Action, page 2, section 2.

First, according to the Office Action, "claims 19, 29, 23, 24, 29 and 34" were rejected "for use of improper Markush groups." Office Action, p. 2, line 12 - 14. Applicants assume the Office meant this to read "claims 19, 20, 23, 24, 29 and 34," and request clarification if this is not correct. Applicants respectfully disagree with the Office that the language of these claims is indefinite, and therefore traverse this rejection.

The phrase "X is chosen from A, B, and C" is proper language and accurately describes the claimed invention, *i.e.*, the composition may contain one or more X with each X independently selected from the group A, B, and C. For example, both Applicants' claim language and the examples the Office points to in M.P.E.P. § 2173.05(h) (see p. 2 of the Office Action) cover a composition of the invention that may contain: A; A and B; or two A's, two B's and a C, as well as all other permutations. However, Applicants' claim language is clearer, and the Office has shown no legal basis for requiring Applicants to change it.

The Office relies on M.P.E.P. § 2173.05(h) for a discussion of proper alternative claim language. However, § 2173.05(h) merely recites examples of proper claim language, which may be representative but are not exclusive. In fact, the U.S. Patent and Trademark Office (PTO) has provided other representative examples of proper alternative claim language.

Specifically, another example of proper alternative claim language is set forth in the M.P.E.P.: "wherein R1 is methyl or phenyl, X and Z are selected from oxygen (O) and sulfur (S)." See M.P.E.P. Appendix AI (PCT), Example 20, p. AI-44 of the July 1998 edition.

In light of the additional examples of proper alternative claim language provided by the PTO, it is clear that there is no reason for the Office to require Applicants to change the claim language of the pending claims. Accordingly, Applicants respectfully submit that this reason for rejection under 35 U.S.C. § 112, second paragraph, is in error, and request that it be withdrawn.

Second, claim 21 was rejected for insufficient antecedent basis for the limitation "alkyl radicals." See Office Action, page 2, lines 14-15. Applicants respectfully traverse this rejection.

In the present application, claim 20 is directed to a composition according to claim 18, wherein the at least one insoluble polymer particle is chosen from copolymers of **alkyl** acrylate, **alkyl** methacrylate, one or more ethylenic carboxylic acids having from 3 to 5 carbon atoms, one or more salts of ethylenic carboxylic acids having from 3 to 5 carbon atoms, and mixtures thereof. Claim 21 is directed to a composition according to claim 20, wherein the **alkyl** radicals contain from 1 to 5 carbon atoms.

As the Office is aware, the failure to provide explicit antecedent basis for terms does not necessarily render a claim indefinite. Rather, even without explicit antecedent basis, if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) ("controlled stream of fluid" provided reasonable antecedent basis

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for "the controlled fluid"); see also *SlimFold Mfg. Co. v. Kinkaid Indus.*, 810 F.2d 1113, 1 USPQ2d 1563 (Fed. Cir. 1987). Furthermore, inherent components of elements recited have antecedent basis in the recitation of the components themselves. See M.P.E.P. 2173.05(e). For example, the limitation "the outer surface of said sphere" would not require an antecedent recitation that the sphere has an outer surface. *Id.*

Applicants respectfully submit that, while claim 21 does not recite, word-for-word, "alkyl radicals," there is, as required under the appropriate standards of 35 U.S.C. §112, second paragraph, sufficient antecedent basis support for the scope of the claim to be reasonably ascertainable by those skilled in the art. Specifically, Applicants respectfully assert that one skilled in the art would readily understand that the alkyl radicals referred to in claim 21 are the alkyl radicals inherent in the alkyl acrylate, and alkyl methacrylate groups recited in claim 20. Accordingly, Applicants respectfully submit that this rejection under 35 U.S.C. § 112, second paragraph, is in error, and request that the rejection be withdrawn.

#### **REJECTION UNDER 35 U.S.C. § 102**

Claims 18 - 21, 24 - 31, 35, 36, 39, and 40 - 45 were rejected under 35 U.S.C. §102(b) as anticipated by WO 92/21316 to Dubief et al. (Dubief), for the reasons set forth on pp. 2-3 of the Office Action. The Office relied upon U.S Patent No. 6,024,946 as a translation of Dubief (Office Action, page 3, line 2), and Applicants do so as well. Applicants respectively traverse this rejection.

In order to anticipate a claim, a reference must contain all elements of the claim. See *Hybritech v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986). Further, a single source must disclose all of the claimed elements

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"arranged as in the claim." See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The law requires identity between the claimed invention and the prior art disclosure. See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 U.S.P.Q. 781, 789 (Fed. 1983). As the cited reference does not disclose all elements arranged as in Applicants' present application, that reference cannot anticipate the invention.

Claim 18, the sole independent composition claim, is directed to a cosmetic composition comprising (a) an aqueous dispersion comprising at least one insoluble polymer particle and (b) an emulsion comprising at least one non-aminated silicone  $\alpha,\omega$ -disilanol. Claims 40 and 43, the only independent process claims in the present application, also contain limitations analogous to element (b).

The Office cites Dubief for teaching, among other things, dimethiconol as a non-aminated silicone  $\alpha,\omega$ -disilanol. However, the Office has not cited, and, in fact, the reference does not teach, that the dimethiconol is present as an emulsion, as in the presently claimed invention. The failure of Dubief to teach a composition comprising an emulsion comprising at least one non-aminated silicone  $\alpha,\omega$ -disilanol is notable in contrast with its specific reference to emulsions of other polymers. See, for example, Examples 1, 2, 7, and 10 of Dubief, each of which explicitly include polymer emulsions different from those claimed in the present application.

Accordingly, at least because Dubief does not teach all of Applicants' presently claimed elements, the rejection under 35 U.S.C. §102 is improper. Reconsideration and withdrawal of the rejection is respectfully requested.

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**REJECTION UNDER 35 U.S.C. 103**

Claims 18 - 39 were rejected under 35 U.S.C. 103(a) as obvious over Dubief in view of U.S. Patent Nos. 6,153,179 to Blankenburg et al. (Blankenburg) and 6,105,577 to Audousett et al. (Audousett), for the reasons set forth on pp. 3-4 of the Office Action. Applicants disagree and respectfully traverse the rejection for at least the reasons discussed below.

The Office carries the initial burden of establishing a *prima facie* case of obviousness, and in doing so must establish: (1) that there exists some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings; (2) that there is a reasonable expectation of success in such a combination; and (3) that the references when combined teach or suggest all limitations of the claim. See M.P.E.P. § 2143. See also *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568 (Fed. Cir. 1996); *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Recently, the Federal Circuit has stated that the evidence of a teaching, suggestion, or motivation to modify or combine must be "clear and particular." See *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). As not all of these requirements have been satisfied in the present case, Applicants maintain that *prima facie* obviousness has not been established.

As noted above, Dubief fails to teach the claimed emulsion comprising at least one non-aminated silicone  $\alpha,\omega$ -disilanol. The secondary references have not been cited for, and, in fact, do not overcome this deficiency. Neither of the secondary references contain any teaching or suggestion of compositions comprising an emulsion comprising

at least one non-aminated silicone  $\alpha,\omega$ -disilanol, nor does the Office point to such a teaching or suggestion, as it must to satisfy its burden under M.P.E.P. § 2143. In fact, neither secondary reference teaches the use of non-aminated silicone  $\alpha,\omega$ -disilanol at all, let alone in emulsion form. Accordingly, neither Blankenburg nor Audousset can remedy this deficiency of Dubief.

Accordingly, for at least the reason that not all the claimed elements are taught or suggested by the combination of references, a *prima facie* case of obviousness has not been established, and thus, the rejection under 35 U.S.C. § 103 is improper.

Reconsideration and withdrawal of the rejection is respectfully requested.

#### CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application, and timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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